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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,799	07/29/2003	Garry R. Marty	8271-26/ 115-3653-U	9409

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EXAMINER

RIVELL, JOHN A

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,799

Applicant(s)

MARTY, GARRY R.

Examiner

John Rivell

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/2/05 (amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-22 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12, 14 and 17 is/are rejected.
- 7) ☒ Claim(s) 6-9, 13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's arguments filed September 2, 2005 have been fully considered but they are not persuasive.

Claim 16 has been canceled. New claims 18-23 have been added. Thus claims 1-15 and 17-23 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15 and 17-22, drawn to a rotary multi-way distributor, classified in class 137, subclass 625.11.
- II. Claim 23, drawn to a selective reciprocal and rotary operated valve, classified in class 137, subclass 625.17.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I has separate utility such as distributing fluids to selected outlets without a further position in which all outlets are supplied. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter and that the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the reasons set for the above.

Since applicant has received an action on the merits for the originally presented invention, e.g. the multi-way distributor as in claim 1, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 10-12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knapp (WO 01/66986) in view of Black.

The document to Knapp (WO 01/66986) discloses, generally in figure 1, a "flow diverter valve assembly comprising: a valve body (4) defining a plurality of flow passageways (11, 12, 13); a rotatable diverter cartridge (17) positioned within said valve body,... a cap (3) assembled into said valve body and being positioned between said valve body (4) and said rotatable diverter cartridge (17),... and means (at valve stem 14) for manually rotating said rotatable diverter cartridge (17) relative to said cap (3) to change one detent engagement to another detent engagement (as represented by the readily apparent spring biased ball detent "trigger mechanism" as disclosed at page 7, line 34 through page 8, line 5) located in the periphery of the "cartridge 17 which cooperates with corresponding detent recesses in the interior periphery of the "cap" 3), wherein each detent engagement corresponds to a different fluid flow selection" as recited in claims 1 and 17.

Thus the document to Knapp (WO 01/66986) discloses all the claimed features with the exception of having "said rotatable diverter cartridge (at 17) defining a plurality of detent recesses (and) said cap (at 3) including at least one deflectable detent finger constructed and arranged to sequentially engage each of said plurality of detent recesses". Essentially, the respective claimed mechanisms, in general, are physically in the opposite locations relative to the locations disclosed in Knapp (WO 01/66986).

The patent to Black discloses that it is known in the art to employ a fixed detent "finger" at 20 cooperating with moving detent "recesses" 22 for the purpose of providing the tactile feel of the detent mechanism to indicate to the operator that the valve is in a certain position.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Knapp (WO 01/66986) a fixed detent "finger" cooperating with a moving detent "recess" by physically for the purpose of providing the tactile feel of the detent mechanism to indicate to the operator that the valve is in a certain position as recognized by Black. This modification is considered to be a full functional equivalent.

Regarding claim 2, in Knapp (WO01/66986), the "rotatable diverter cartridge (17) defines a flow inlet port (10) and three outflow ports (11, 12, 13)" as recited.

Regarding claims 3 and 10, there are believed to be as many detent recesses cooperating with the spring loaded detent mechanism as there are positions of the diverter cartridge. As shown there are at least "six" positions as in figs. 5-11.

Regarding claims 4, 5, 11 and 12, the inclusion of "a pair of detent fingers" is considered to be nothing more than an obvious duplication of the detent mechanism in Knapp (WO 01/66986) for a multiplied effect.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knapp (WO 01/66986) in view of Black as applied to claims 1-5, 10-12 and 17 above, further in view of Breda (U.S. Pat. No. 6,196,266 cited by applicant).

The document to Knapp (WO 01/66986), as modified by Black, discloses all the claimed features with the exception of having "an annular O-ring positioned between said cap (3) and said valve body (4)".

The patent to Breda ('266) discloses that it is known in the art to employ an "annular O-ring" at seal 31 between the "cap" 32 and the valve body 11 for the purpose of sealing the interface therebetween against fluid leakage.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Knapp (WO 01/66986), as modified by Black, an annular O-ring between the valve body 4 and the cap 3 for the purpose of sealing the interface therebetween against fluid leakage as recognized by Breda ('266).

Regarding applicants remarks concerning the above, contrary to applicants position, all of the claimed structural elements recited in claim 1 for example are present in Knapp (WO 01/66986). That is, clearly shown is a "detent" mechanism, at the spring loaded ball element identified in the disclosure of Knapp (WO 01/66986) as a trigger mechanism 19 (the lack of a number "19" in the drawings is irrelevant), equivalent to the claimed "detent finger" which is physically located in the "cartridge. Cooperating with the spring loaded ball element are a plurality of "recesses" spaced about the periphery of the valve body which, when the ball falls there into, effects a tactile sensation felt by the operator indicating location of the valve element at a particular location commensurate with a selected position of the rotor to deliver water from the inlet to the selected outlet(s). As compared with the claimed location of these respective elements, in Knapp (WO 01/66986) they are physically located in opposite locations.

The patent to Black is relied on to demonstrate that it is known in the valve art to employ a rotary valve mechanism in which the physical location of the particular detent mechanism elements are located as claimed. That is, Black teaches one of ordinary skill in the art to employ a detent mechanism in which a fixed detent "finger" at 20 cooperates with moving detent "recesses" 22 for the purpose of providing the tactile feel of the detent mechanism to indicate to the operator that the valve is in a certain position. As t related to Knapp (WO 01/66986), the teaching of Black suggests to one of ordinary skill in the art the employment of a detent mechanism in which the elements of Knapp (WO 01/66986) can be oppositely positioned. For example, as Black teaches one to locate the detent mechanism in the fixed portion of the valve element, as applied to Knapp (WO 01/66986), one would be taught by Black to relocate the spring loaded ball element of Knapp (WO 01/66986) such that it is located in the fixed valve body 3 of Knapp (WO 01/66986) and to relocate the recesses of Knapp (WO 01/66986) such that they are located in the rotary valve element 17, 18 of Knapp (WO 01/66986).

In response to applicant's argument that "it would be virtually impossible to figure out how Knapp could even be changed to accept element 20 and 22 of Black", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In contrast to applicants opinion that "substantial or significant changes would be necessary to incorporate elements 20 and 22 of Black into Knapp" physical incorporation is not required. To adopt the teachings of Black into Knapp (WO

01/66986), one need only physically relocate the elements already located in Knapp (WO 01/66986) to the positions taught by Black.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reference to Black is relied on to demonstrate that it is known in the valve art to employ a detent mechanism on a rotary valve in which the detent mechanism elements are physically located as claimed.

Claims 18-22 are allowed.

Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13 and 15 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 20 and 21, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (571) 272-4918. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Blau can be reached on (571) 272-4406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Rivell
Primary Examiner
Art Unit 3753

j.r.